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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,726	08/04/2006	Anthony Dean Askew	148/433US	5435
23638	7590	09/01/2009	EXAMINER	
ADAMS INTELLECTUAL PROPERTY LAW, P.A. Suite 2350 Charlotte Plaza 201 South College Street CHARLOTTE, NC 28244			VASISTH, VISHAL V	
ART UNIT	PAPER NUMBER			
	1797			
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09/01/2009	PAPER			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/597,726	ASKEW, ANTHONY DEAN	
	<b>Examiner</b>	<b>Art Unit</b>	
	VISHAL VASISTH	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 August 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-24 and 26-28 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-24 and 26-28 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 27 is objected to because of the following informalities: claim 27 depends on "claim 1 or 25," but claim 25 is a cancelled claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 27 provides for the "use of the aqueous hydraulic fluid . . . in an off-shore mineral or mining drilling apparatus," but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 27 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

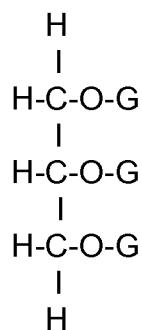
6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

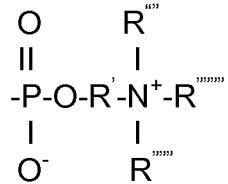
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5, 9-14, 16-20 and 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Rizvi et al., US Patent No. 4,846,985 (hereinafter referred to as Rizvi).

Rizvi discloses an aqueous composition for use in hydraulic fluids (as recited in claims 1 and 26) (Col. 10/L. 57-58) comprising at least about 70 wt% water (Col. 22/L. 54), 0.1 to 1 wt% of an emulsion stabilizer such as phosphatides of the following formula:



wherein G is selected from the class consisting of fatty acyl groups and phosphorus-containing groups having the structural grouping:



wherein  $\text{R}^{''}$  is a lower alkylene group having from 1 to about 10 carbon atoms and  $\text{R}^{''''}$ ,  $\text{R}^{''''}$  and  $\text{R}^{''''''}$  are lower alkyl groups having from 1 to 4 carbon atoms and at least one but no more than two of the G groups being said phosphorus-containing group (as recited in claims 1, 4-5, 9-10, 26 and 28) (Col. 18/L. 20-44 and Col. 19/L. 58-62), and less than about 6 wt% of a hydrocarbon oil (as recited in claims 1, 20 and 26) (Col. 22-23/L. 67-2).

Rizvi discloses that the fatty acyl groups of the phosphatides are especially desirable when derived from commercial fatty compounds such as soybean oil, cotton seed oil, and castor oil. A particularly effective phosphatide is soybean lecithin (as recited in claims 11-14 and 26) (Col. 18/L. 49-55).

Rizvi further discloses the additives that enhance the properties of the composition. These additives include corrosion inhibitors such as hydrocarbyl amines and alkanol amines (as recited in claims 16-17) (Col. 27/L. 17-52) and anti-freeze additives such as ethylene glycol (as recited in claims 18-19 and 26) (Col. 28/L. 15-22).

Rizvi does not explicitly disclose the hydraulic composition for use in an off-shore mineral or mining drilling apparatus, it is the position of the examiner that the

composition disclosed in Rizvi inherently possesses the functions capable of use in an off-shore mineral or mining drilling apparatus.

***Claim Rejections - 35 USC § 102***

8. Claims 1-3, 9-10, 15, 20-24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Khan et al., US Patent No. 6,066,602 (hereinafter referred to as Khan).

Khan discloses a lubricant composition comprising a Pluronic polyol lubricant in a concentration of 0 wt% (as recited in claims 1, 15 and 20-23), a synthetic phospholipid compound in a concentration of 8 wt% (as recited in claims 1, 9-10 and 15), water in a concentration of 92 wt% (as recited in claim 1-3) (Col. 5/L. 40-50) and no phosphorodithioates (as recited in claim 24).

Case law holds that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the composition of Khan is capable of acting as a hydraulic fluid, and therefore meets the limitations of claim 1.

Khan does not explicitly disclose the hydraulic composition for use in an off-shore mineral or mining drilling apparatus, it is the position of the examiner that the composition disclosed in Khan inherently possesses the functions capable of use in an off-shore mineral or mining drilling apparatus.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rizvi in view of Luciani et al., US Patent No. 5,487,838 (hereinafter referred to as Luciani).

Rizvi discloses a hydraulic fluid composition comprising a phosphatide stabilizer derived from a soybean lecithin. Rizvi does not, however, explicitly disclose the presence of multiple phospholipids in the composition especially not the phospholipids; phosphatidylcholine, phosphatidylinositol and phosphatidylethanolamine.

Luciani discloses a hydraulic fluid aqueous composition (see Abstract and Col. 22/L. 67) comprising a boron compound and a phospholipid wherein examples of phospholipids include phosphatidylcholine, phosphatidylinositol and phosphatidylethanolamine and mixtures thereof (see Abstract and Col. 2/L. 53-58 and

Col. 3/L. 41-47). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the phospholipids of Luciani in the composition of Rizvi in order to enhance the bacteriostatic effects of the composition (see Abstract of Luciani).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VISHAL VASISTH whose telephone number is (571)270-3716. The examiner can normally be reached on M-R 8:30a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Calderola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VVV

/Glenn A Calderola/  
Acting SPE of Art Unit 1797

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